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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.     | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------|------------------|
| 10/512,101  | 10/21/2004  | Michael Rooke        | 915-006.054             | 6418             |
| 4955  | 7590        | 11/07/2006           | EXAMINER                |                  |
| WARE FRESSOLA VAN DER SLUYS &<br>ADOLPHSON, LLP<br>BRADFORD GREEN, BUILDING 5<br>755 MAIN STREET, P O BOX 224<br>MONROE, CT 06468 |             |                      | HOLLIDAY, JAIME MICHELE |                  |
|   |             |                      | ART UNIT                | PAPER NUMBER     |
|   |             |                      | 2617                    |                  |
| DATE MAILED: 11/07/2006   |             |                      |                         |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/512,101             | ROOKE ET AL.        |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Jaime M. Holliday      | 2617                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 24 August 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-18 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ .  | 6) <input type="checkbox"/> Other: _____ .                        |

***Response to Amendment***

***Response to Arguments***

1. Applicant's arguments filed August 24, 2006 have been fully considered but they are not persuasive.

Applicants basically argue that Salin et al. fail to disclose "subscribing to said presence service for receipt of notifications about the attainability of said mobile terminal device," and "initiating a delivery attempt of said message to said mobile terminal device in accordance with the result of said checking, wherein said availability information for the acceptance of said messages by said mobile terminal device." Specifically, Applicants argue that Salin et al discloses determining the reachability of a subscriber mobile station after a short message delivery attempt has been initiated based in the expiration of a set time. Also, Applicants argue that Salin discloses initiating a delivery attempt for a message when the time specified by the time supervision expires.

With regards to the above argument, Examiner respectfully disagrees. Salin et al. clearly show and disclose a method for delivering short messages to mobile stations. As cited in the previous Office Action, a Set Message Waiting Data message is sent to the HLR of the MS in response to a failed delivery attempt (Failure Report) to the SMS-GMSC, and the receipt of Set Message Waiting Data message from SMS-GMSC to HLR is acknowledged. In particular, a flag is set (MSNRF) by both the SGSN and the HLR (subscribing to presence subscriber). When the SGSN receives a message on the presence of the MS (mobile station is again reachable), it detects that the flag is set, clears it and sends this information to the HLR (col. 8 line 59 col. 10 line 6). As cited in

the previous action, the short message is forwarded to SMS-GSMC when SM-SC receives an alert message from the SMS-GMSC, wherein an alert message is sent to SMS-GMSC, in response to mobile station updating its routing area to the serving node (initiating a delivery attempt of a message in accordance with checking availability information). The short message is forwarded when the mobile station updates its location and can be reached, not when a set time expires.

Therefore, in view of the above reasons, Examiner maintains previous rejections.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1, 2, 4, 5, and 8-18** are rejected under 35 U.S.C. 102(b) as being anticipated by **Salin et al. (U.S. Patent # 6,370,390 B1)**.

Consider **claim 1**, Salin et al. clearly show and disclose a method for delivering short messages to mobile stations, reading on the claimed “method for delivering messages to a mobile terminal device.” Salin et al. further disclose a situation where a mobile station MS is attached to a GPRS network and a GSM network, and the short message service center (SM-SC) has received a short message (SM) for delivery to the mobile station, but the mobile station cannot be

reached. The SM-SC first forwards the short message to the gateway mobile switching center for short message service (SMS-GMSC) which proceeds to request routing information for the short message from the home location register (HLR) of the mobile station, reading on the claimed "Method for delivering messages to a mobile terminal device in case of an unsuccessful message delivery attempt to said mobile terminal device from a Store-and-Forward Entity of a mobile communication network having a presence service," (abstract, column 7 lines 60-65 and column 8 lines 8-16) characterized by: sending a Set Message Waiting Data message to the HLR of the MS in response to a failed delivery attempt (Failure Report) to the SMS-GMSC, reading on the claimed "receiving a notification about an unsuccessful delivery attempt of said message," (figure 2, column 8 lines 39-42 and 59-62) and acknowledging receipt of Set Message Waiting Data message from SMS-GMSC to HLR, reading on the claimed "and subscribing to said presence service for receipt of notifications about the attainability of said mobile terminal device," (figure 2, column 9 lines 1-4), sending alert message to SMS-GMSC, in response to mobile station updating its routing area to the serving node (SGSN) and the serving node sending this information to the HLR, reading on the claimed "checking availability information of said mobile terminal device in said presence service for an acceptance of said message by said mobile terminal device," (figure 2, column 9 lines 20-22, 30-32 and 35-37), forwarding short message to SMS-GSMC when SM-SC receives an alert message from the SMS-GMSC, reading on the claimed "initiating a delivery

attempt of said message to said mobile terminal device," (figure 2, column 9 lines 45-52), the SMS-GMSC examines the address of the mobile station and request routing information from the HLR which returns an acknowledgment of the message with the current SGSN address and the MSC/VLR address of the mobile station, reading on the claimed "in accordance with the result of said checking, wherein said availability information for the acceptance of said messages by said mobile terminal device comprises information selected from a group of: type of message, size of the message, data content of the message, location of said mobile terminal device and willingness of a user of said mobile terminal device to receive a message" (figure 2, column 9 lines 53-64).

Consider **claim 2**, and as applied claim 1 above, Salin et al. further disclose SGSN sending information on the fact that the mobile station is again reachable to the HLR which sends an alert message to the SMS-GMSC. The SMS-GMSC then sends an alert message to the SM-SC, which then forwards the short message to the SMS-GMSC, reading on the claimed "receiving a status change notification message from said presence service about said mobile terminal device having a change of said availability information, starting a delivery attempt of said message to said mobile terminal device, in accordance with said received status change notification message" (column 9 lines 29-37).

Consider **claim 4**, and as applied claim 1 above, Salin et al. further disclose the SM-SC receives a short message for delivery to the mobile station,

reading on the claimed "receiving of said message to be transmitted to said mobile terminal device" (column 7 lines 63-65).

Consider **claim 5**, and **as applied claim 1 above**, Salin et al. further disclose the SGSN sending information on the fact that the mobile station is again reachable, to the HLR, in response to the mobile station sending the SGSN a message on its presence. Then SMS-GSMC receives an alert from the HLR, reading on the claimed "checking availability information of said mobile terminal device in said presence service for the availability of said mobile terminal device" (column 9 lines 30-37).

Consider **claim 8**, and **as applied claim 1 above**, Salin et al. further disclose the mobile station updating its routing area and sending a message on its presence to the SGSN, which proceeds to send this information to the HLR, reading on the claimed "availability information of said mobile terminal device in said presence service can arbitrarily be changed by receiving said presence service status change message from said mobile terminal device" (column 9 lines 21-32).

Consider **claims 9, 10 and 11**, and **as applied to claim 1 above**, Salin et al. further disclose a SMS-GMSC receiving short messages for delivery to a mobile station, reading on the claimed "Store-and-Forward Entity," (col. 2 lines 1-4), in which it is known in the art that mobile switching centers may comprise processors to perform functions that may be implemented with instructions in accordance with program codes or software algorithms. Salin et al. further

disclose a method for delivering short messages to mobile stations, reading on the claimed "method for delivering messages to a mobile terminal device." Salin et al. further disclose a situation where a mobile station MS is attached to a GPRS network and a GSM network, and the short message service center (SM-SC) has received a short message (SM) for delivery to the mobile station, but the mobile station cannot be reached. The SM-SC first forwards the short message to the gateway mobile switching center for short message service (SMS-GMSC) which proceeds to request routing information for the short message from the home location register (HLR) of the mobile station, reading on the claimed "Method for delivering messages to a mobile terminal device in case of an unsuccessful message delivery attempt to said mobile terminal device from a Store-and-Forward Entity (SFE) of a mobile communication network having a presence service, said presence service providing an information about the attainability of said mobile terminal device," (abstract, column 7 lines 60-65 and column 8 lines 8-16) characterized by: sending a Set Message Waiting Data message to the HLR of the MS in response to a failed delivery attempt (Failure Report) to the SMS-GMSC, reading on the claimed "receiving a notification about an unsuccessful delivery attempt of said message," (figure 2, column 8 lines 39-42 and 59-62) and acknowledging receipt of Set Message Waiting Data message from SMS-GMSC to HLR, reading on the claimed "and subscribing to said presence service for receipt of notifications about the attainability of said mobile terminal device," (figure 2, column 9 lines 1-4), sending alert message to SMS-

GMSC, in response to mobile station updating its routing area to the serving node (SGSN) and the serving node sending this information to the HLR, reading on the claimed "checking availability information of said mobile terminal device in said presence service for an acceptance of said message by said mobile terminal device," (figure 2, column 9 lines 20-22, 30-32 and 35-37), forwarding short message to SMS-GMSC when SM-SC receives an alert message from the SMS-GMSC, reading on the claimed "initiating a delivery attempt of said message to said mobile terminal device," (figure 2, column 9 lines 45-52), the SMS-GMSC examines the address of the mobile station and request routing information from the HLR which returns an acknowledgment of the message with the current SGSN address and the MSC/VLR address of the mobile station, reading on the claimed "in accordance with the result of said checking, wherein said availability information for the acceptance of said messages by said mobile terminal device comprises information selected from a group of: type of message, size of the message, data content of the message, location of said mobile terminal device and willingness of a user of said mobile terminal device to receive a message" (figure 2, column 9 lines 53-64).

Consider **claims 12 and 17**, Salin et al. clearly show and disclose a SM-SC and SMS-GMSC connected to a GSM network, reading on the claimed "Store-and-Forward Entity connectable to a mobile communication network," wherein the SM-SC forwards a short message to the SMS-GMSC which examines the address of the mobile station and requests routing information for a

short message from the HLR, reading on the claimed, "an apparatus," (column 6 lines 19-23 and column 8 lines 8-15) comprising by: returning a message on a failed delivery attempt from the SGSN to the SMS-GMSC, reading on the claimed "a component (means) for receiving a notification about an unsuccessful delivery attempt of a message," (column 8 line 39-42) and sending a Set Message Waiting Data message to the HLR of the mobile station which includes a parameter indicating the mobile station could not be reached, reading on the claimed, "a component (means) for subscribing to a presence service for receipt of notifications about the attainability status of a mobile terminal device," (column 8 lines 59-65) wherein HLR returns the current SGSN address and the MSC/VLR address of the mobile station, reading on the claimed "presence service is for storing and forwarding said message to said mobile terminal device, and provides an information about acceptance of said message selected from the group comprising: message type, message size, message content, sender type, sender, and location of said mobile terminal device" (column 8 lines 20-25).

Consider **claims 13 and 18, and as applied claims 12 and 17 above**, respectively, Salin et al. further disclose the HLR sending an alert message to the SMS-GMSC when it receives information that the mobile station is again reachable. The SMS-GMSC then sends an alert message to the SM-SC which proceeds to forwards the short message to the SMS-GMSC, reading on the claimed "a component (means) for checking availability information of said presence service for an acceptance of said message by said mobile terminal,

and a component (means) configured to initiate a delivery attempt of said message to said mobile terminal device, in accordance with the operation of said checking component" (column 9 lines 32-37 and 45-51).

Consider **claim 14**, and **as applied claim 13 above**, Salin et al. further disclose the HLR sending an alert message to the SMS-GMSC when it receives information that the mobile station is again reachable, reading on the claimed "a component for checking availability information of said presence service for the availability of said mobile terminal device" (column 9 lines 32-37).

Consider **claim 15**, and **as applied claim 13 above**, Salin et al. further disclose the SM-SC receiving a short message for delivery to the mobile station, reading on the claimed "a component for receiving messages to be transmitted to said mobile terminal device" (column 7 lines 63-65).

Consider **claim 16**, and **as applied claim 12 above**, Salin et al. further disclose when the mobile station becomes reachable it sends a message on its presence to the SGSN that sends this information on to the HLR, reading on the claimed "a component to change said availability information in said presence service of said mobile terminal device according to the reception of a presence service status change message from said mobile terminal device" (column 9 lines 21-24 and 30-32).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. **Claims 3, 6 and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Salin et al. (U.S. Patent # 6,370,390 B1)** in view of **Rooke et al. (U.S. Patent 6,678,361)**.

Consider **claim 3**, and as applied to **claim 1**, Salin et al. show and disclose the claimed invention except that the message delivered is a multi media message.

In the same field of endeavor, Rooke et al. clearly show and disclose a method for delivering messages in a communication network consisting of at least one terminal and a messaging functionality, reading on the claimed "method for delivering messages to a mobile terminal device from a Store-and-Forward Entity (SFE) of a mobile communication network." A submission of a multimedia message as an example for a message to be delivered in a communication network is handled according to capabilities and a user profile of a recipient terminal like for example a mobile station, reading on the claimed "message is a multi media message," (column 1 line 66- column 2 line 2 and column 3 lines 8-12).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to allow multimedia messages to be delivered in a communication network as taught by Rooke et al. in the method of Salin et al. in order to permit subscribers to send and receive different types of messages.

Consider **claim 6**, and as applied to **claim 1 above**, Salin et al. clearly show and disclose the claimed invention except that the availability information is dependent on properties of the message.

In the same field of endeavor, Rooke et al. clearly show and disclose a method for delivering messages in a communication network consisting of at least one terminal and a messaging functionality, reading on the claimed "method for delivering messages to a mobile terminal device from a Store-and-Forward Entity (SFE) of a mobile communication network." A new multimedia message is received by the multimedia messaging service center (MMSC), which is able to decide which type of delivery has to be selected, based on the terminal capabilities and the current user profile stored in the MMSC, reading on the claimed "availability information for acceptance of said message is depending on properties of said message" (column 1 line 66- column 2 line 2 and column 3 lines 25-33).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to allow the MMSC to the delivery of multimedia messages (column 4 lines 23-25) as taught by Rooke et al. in the method of Salin et al. in order to reduce signaling when short messages are sent (Salin et al.; column 5 lines 34-35).

Consider **claim 7**, and as applied to **claim 6 above**, Salin et al. clearly show and disclose the claimed invention except that the availability information is

dependent on properties, such as message type, size, sender type of sender, of the message.

In the same field of endeavor, Rooke et al. clearly show and disclose the decision how to handle the submission of a multimedia message is based on the circumstance that content(s), size and type(s) of the multimedia message, the capabilities of the terminal, and the user profile of a subscriber related to the terminal are available to decision means, reading on the claimed "properties are selected from a group comprising: message type, message size, sender type, and sender" (column 3 lines 8-16).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to allow the MMSC to use the size and type of message to decide on delivery of multimedia messages as taught by Rooke et al. in the method of Salin et al. in order to reduce signaling when short messages are sent (Salin et al.; column 5 lines 34-35).

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

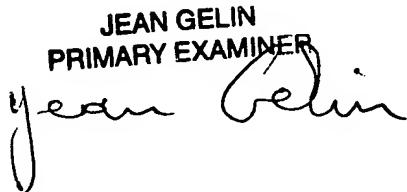
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jaime M. Holliday whose telephone number is (571) 272-8618. The examiner can normally be reached on Monday through Friday 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Jaime Holliday  
Patent Examiner

  
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